

Atty. Docket No. MP0376
Serial No: 10/734,779

Remarks

The Examiner has required restriction between groups of claims in the above-identified application as follows:

Group I: Claims 37-46, drawn to a method of making a structure configured to disconnect circuit elements; and

Group II: Claims 1-36, drawn to a structure configured to disconnect circuit elements.

Applicants have elected Group II, Claims 1-36, drawn to a structure configured to disconnect circuit elements, with traverse.

Restriction is proper only when the groups of claims are (A) independent or distinct as claimed, and (B) there is a serious burden on the Examiner (M.P.E.P. 803). Claims are independent when there is no disclosed relationship between them; for example, a process and an apparatus that is incapable of being used in practicing the process (M.P.E.P. 802.01). Claims are distinct when they are related as disclosed, but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (M.P.E.P. 802.01; emphasis in original). Examiners must provide reasons and/or examples in support of their conclusions (M.P.E.P. 803).

In this case, the Examiner has mischaracterized at least some of the claims in Group I, and has failed to carry the burden of persuasion with regard to providing reasons and/or examples in support of the conclusion of distinctness. As a result, the Restriction Requirement is improper, and should be withdrawn.

At Least Some of the Claims in Group I Have Been Mischaracterized

The Examiner has mischaracterized at least some of the claims in Group I. Group II, Claims 1-36, are in fact drawn to a product. However, only part of Group I, Claims 37-42, are

Atty. Docket No. MP0376
Serial No: 10/734,779

related as a process for making the product. Furthermore, the Examiner's statement to the effect that the process claims in Group I require "irradiating at least one first lens on or near a surface of the circuit sufficient to electrically disconnect a corresponding first fuse and disable a first configuration of the circuit" is not accurate. For convenience, Claims 37-42 are reproduced below:

37. A method of making a structure configured to disconnect circuit elements, comprising the steps of:
 - a) forming a conductive structure electrically coupled to first and second circuit elements, said first conductive structure absorbing a first wavelength of light with a minimum threshold efficiency;
 - b) forming a first dielectric layer thereover, said first dielectric layer being substantially transparent to said first wavelength of light; and
 - c) forming a first lens on or over said first dielectric layer, and over said conductive structure, said first lens being substantially opaque to said first wavelength of light and being configured to at least partially focus light having said first wavelength onto said conductive structure.
38. The method of Claim 37, further comprising the step of forming said first and second circuit elements before forming said conductive structure.
39. The method of Claim 38, further comprising the step of forming electrical contacts to said first and second circuit elements before forming said conductive structure.
40. The method of Claim 37, wherein the step of forming said conductive structure further comprises simultaneously forming a first plurality of conductive structures.

Atty. Docket No. MP0376
Serial No: 10/734,779

41. The method of Claim 37, wherein the step of forming said first lens further comprises simultaneously forming a second plurality of conductive structures.
42. The method of Claim 37, further comprising the steps of:
 - a) forming a second dielectric layer on or over said first lens, and
 - b) forming a second lens over said second dielectric layer, said second lens being substantially opaque to said first wavelength of light and being configured to at least partially focus light having said first wavelength onto said first lens.

None of these claims in Group I require "irradiating at least one first lens on or near a surface of the circuit sufficient to electrically disconnect a corresponding first fuse and disable a first configuration of the circuit." Thus, the Examiner appears to have mischaracterized at least some of the claims in Group I. As a result, the alternative reason and/or example provided in support of restriction and the conclusion of distinctness (p. 2, last 5 lines of the Office Action of December 15, 2004) does not find support in the claims reproduced above. Consequently, the Examiner's alternative reason and/or example does not carry the burden of persuasion in support of the conclusion of distinctness is improper, and restriction would appear to be improper on this basis.

No Proper Reason or Example in Support of Distinctness Has Been Provided

The Examiner appears to have argued that the product as claimed in Group II, Claims 1-36, can be made by doping or thermally heating, and that such processes are materially different than the process claimed in Group I. However, as shown above, Claim 37 recites three (3) steps therein, each one beginning with the term "forming." Furthermore, none of the "forming" steps in any of Claims 37-42 above refer to any particular technique, such as doping, heating, irradiating or otherwise, by which the structure is formed. Thus, it is not at all clear how doping

Atty. Docket No. MP0376
Serial No: 10/734,779

or thermally heating can be processes that are materially different than the process claimed in Claims 37-42 above.

As a result, the Examiner has failed to carry the burden of persuasion with regard to providing reasons and/or examples in support of the conclusion of distinctness. As a result, the Restriction Requirement is improper, and should be withdrawn.

Finally, the Examiner's attention is drawn to 37 C.F.R. 1.141(b), which states:

"Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made."

Conclusions

Applicants have elected Group II, Claims 1-36, drawn to a structure configured to disconnect circuit elements, with traverse. However, in view of (1) the mischaracterization of at least some of the claims in Group I and (2) the Examiner's failure to provide a single proper or plausible reason or example in support of the conclusion of distinctness, the Restriction Requirement is improper and should be withdrawn. Thus, in view of the above election and remarks, Claims 1-46 are in condition for examination on the merits. Early notice to that effect is earnestly requested.

Atty. Docket No. MP0376
Serial No: 10/734,779

If it is deemed helpful or beneficial to the efficient prosecution of the present application,
the Examiner is invited to contact Applicant's undersigned representative by telephone.

Respectfully submitted,



Andrew D. Fortney, Ph.D.
Reg. No. 34,600
Telephone: (559) 299 - 0128

Until further notice, please continue to send all correspondence to:

Eric B. Janofsky
Vice President and General Patent Counsel
Marvell Semiconductor, Inc.
700 First Avenue, M/S 509
Sunnyvale, California 94089
(408) 222 - 2500